



93-04-09

IFB

PTO/SB/17 (02-07)

Approved for use through 02/28/2007. OMB 0651-0032  
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

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Effective on 12/08/2004.  
Fees pursuant to the Consolidated Appropriations Act, 2005 (H.R. 4818).**FEE TRANSMITTAL**  
**For FY 2007**☒ Applicant claims small entity status. See 37 CFR 1.27**TOTAL AMOUNT OF PAYMENT** (\$) 180.00**Complete if Known**

Application Number	10/760,091
Filing Date	January 16, 2004
First Named Inventor	Thomas L. CANTOR
Examiner Name	C. Cheu
Art Unit	1641
Attorney Docket No.	532212000624

**METHOD OF PAYMENT** (check all that apply)☐ Check ☐ Credit Card ☐ Money Order ☐ None ☐ Other (please identify): \_\_\_\_\_☒ Deposit Account Deposit Account Number: 03-1952 Deposit Account Name: Morrison & Foerster LLP

For the above-identified deposit account, the Director is hereby authorized to: (check all that apply)

☒ Charge fee(s) indicated below ☐ Charge fee(s) indicated below, except for the filing fee  
☒ Charge any additional fee(s) or underpayments of fee(s) under 37 CFR 1.16 and 1.17 ☒ Credit any overpayments**FEE CALCULATION****1. BASIC FILING, SEARCH, AND EXAMINATION FEES**

Application Type	FILING FEES		SEARCH FEES		EXAMINATION FEES		Fees Paid (\$)
	Fee (\$)	Small Entity Fee (\$)	Fee (\$)	Small Entity Fee (\$)	Fee (\$)	Small Entity Fee (\$)	
Utility	300	150	500	250	200	100	
Design	200	100	100	50	130	65	
Plant	200	100	300	150	160	80	
Reissue	300	150	500	250	600	300	
Provisional	200	100	0	0	0	0	

**2. EXCESS CLAIM FEES**

Fee Description	Fee (\$)	Small Entity Fee (\$)
Each claim over 20 (including Reissues)	50	25
Each independent claim over 3 (including Reissues)	200	100
Multiple dependent claims	360	180

Total Claims	Extra Claims	Fee (\$)	Fee Paid (\$)
_____ - 20 = _____	x _____	= _____	

HP = highest number of total claims paid for, if greater than 20.

Indep. Claims	Extra Claims	Fee (\$)	Fee Paid (\$)
_____ - 3 = _____	x _____	= _____	

HP = highest number of independent claims paid for, if greater than 3.

Multiple Dependent Claims	Fee (\$)	Fee Paid (\$)
_____		

**3. APPLICATION SIZE FEE**

If the specification and drawings exceed 100 sheets of paper (excluding electronically filed sequence or computer listings under 37 CFR 1.52(e)), the application size fee due is \$250 (\$125 for small entity) for each additional 50 sheets or fraction thereof. See 35 U.S.C. 41(a)(1)(G) and 37 CFR 1.16(s).

Total Sheets	Extra Sheets	Number of each additional 50 or fraction thereof	Fee (\$)	Fee Paid (\$)
_____ - 100 = _____	/50	_____ (round up to a whole number) x _____	= _____	

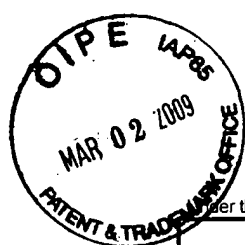
**4. OTHER FEE(S)**

Non-English Specification, \$130 fee (no small entity discount)

Other (e.g., late filing surcharge): 1806 Submission of an Information Disclosure Statement 180.00

**SUBMITTED BY**

Signature		Registration No. (Attorney/Agent)	43,543	Telephone	(858) 720-5117
Name (Print/Type)	Peng Chen	Date	March 2, 2009		



PTO/SB/21 (12-07)

Approved for use through 12/31/2007. OMB 0651-0031

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

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**TRANSMITTAL  
FORM**

(to be used for all correspondence after initial filing)

<b>TRANSMITTAL FORM</b>  (to be used for all correspondence after initial filing)	Application Number	10/760,091	
	Filing Date	January 16, 2004	
	First Named Inventor	Thomas L. CANTOR	
	Art Unit	1641	
	Examiner Name	C. Cheu	
Total Number of Pages in This Submission	10	Attorney Docket Number	532212000624

**ENCLOSURES (Check all that apply)**

<input checked="" type="checkbox"/> Fee Transmittal Form (1 page)	<input type="checkbox"/> Drawing(s)	<input type="checkbox"/> After Allowance Communication to TC
<input type="checkbox"/> Fee Attached	<input type="checkbox"/> Licensing-related Papers	<input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences
<input type="checkbox"/> Amendment/Reply	<input type="checkbox"/> Petition	<input type="checkbox"/> Appeal Communication to TC (Appeal Notice, Brief, Reply Brief)
<input type="checkbox"/> After Final	<input type="checkbox"/> Petition to Convert to a Provisional Application	<input type="checkbox"/> Proprietary Information
<input type="checkbox"/> Affidavits/declaration(s)	<input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address	<input type="checkbox"/> Status Letter
<input type="checkbox"/> Extension of Time Request	<input type="checkbox"/> Terminal Disclaimer	<input checked="" type="checkbox"/> Other Enclosure(s) (please identify below):
<input type="checkbox"/> Express Abandonment Request	<input type="checkbox"/> Request for Refund	Form PTO/SB/08A/B (2 pages + duplicate)
<input checked="" type="checkbox"/> Information Disclosure Statement (Supplemental - 4 pages)	<input type="checkbox"/> CD, Number of CD(s) _____	References (37)
<input type="checkbox"/> Certified Copy of Priority Document(s)	<input type="checkbox"/> Landscape Table on CD	Return Receipt Postcard
<input type="checkbox"/> Reply to Missing Parts/Incomplete Application	<b>Remarks</b>	
<input type="checkbox"/> Reply to Missing Parts under 37 CFR 1.52 or 1.53	Customer No. 25225	

**SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT**

Firm Name	MORRISON & FOERSTER LLP		
Signature			
Printed name	Peng Chen		
Date	March 2, 2009	Reg. No.	43,543

I hereby certify that this paper and the accompanying documents are being deposited with the U.S. Postal Service as Express Mail, Airbill No. EV 814072446 US, on the date shown below in an envelope addressed to: MS Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Dated: March 2, 2009

Signature:

(Diane Blevins)

I hereby certify that this paper is being deposited with the U.S. Postal Service as Express Mail, Airbill No. EV 814072446 US, on the date shown below in an envelope addressed to: MS Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Dated: March 2, 2009

Signature: \_\_\_\_\_

(Diane Blevins)

Patent

Docket No. 532212000624

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:  
Thomas L. CANTOR et al.

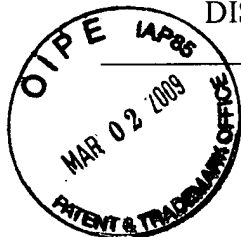
Serial No.: 10/760,091

Filing Date: January 16, 2004

For: METHODS FOR DIFFERENTIATING  
AND MONITORING PARATHYROID  
AND BONE STATUS RELATED  
DISEASES

Examiner: C. Cheu

Group Art Unit: 1641



### SUPPLEMENTAL INFORMATION DISCLOSURE STATEMENT UNDER 37 C.F.R. § 1.97 & 1.98

MS Amendment  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

Pursuant to 37 C.F.R. §1.97 and § 1.98, Applicants submit for consideration in the above-identified application the document listed on the attached Form PTO/SB/08a/b. Copies of the non-patent literature documents are submitted herewith. The Examiner is requested to consider and make these documents of record.

Document numbers 4-12 are from *Scantibodies Laboratory, Inc. v. Immutopics, Inc.*, at the United States District Court for the Central District of California, Case No. CV 04-08871 MRP (MANx), appealed at the United States Court of Appeals for the Federal Circuit, Case No. 2008-1522. This litigation involves U.S. Patent No. 6,689,566. The present application is Continuation of U.S. Patent No. 6,743,590, which is a Continuation-in-Part of U.S. Patent No. 6,689,566. Scantibodies Laboratory, Inc. is the assignee of the present application.

sd-440114

03/05/2009 LTRUONG 00000035 031952 10760091

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Document number 6 is an Amended Claim Construction Order. The Court vacated the previous claim construction order and reached the following construction of terms:

1. "Specific for" is defined as having a measurable affinity for and detectable binding to an epitope having at least four amino acids of the seven in SEQ ID NO: 3. In addition, the affinity is higher than the affinity for any other epitope of the whole PTH sequence.

2. "Specifically binds to whole parathyroid hormone" means having a measurable affinity for and detectable binding to whole parathyroid hormone.

3. "Does not specifically bind to an interfering non-(1-84) parathyroid hormone fragment" means having no measurable affinity for and no detectable binding to an interfering non-(1-84) parathyroid hormone fragment, the fragment as defined below. No measurable affinity means an association constant of less than 105 liter/mole.

4. "Not detecting an interfering non-(1-84) parathyroid hormone fragment" is construed to mean having no detectable binding to an interfering non-(1-84) parathyroid hormone fragment.

Document number 10 is a Second Amended Claim Construction Order. The Court vacated the previous claim construction orders and reached the following construction of terms:

1. "Specific for" is defined as having a measurable affinity for and detectable binding to an epitope having at least four amino acids of the seven in SEQ ID NO: 3. In addition, the affinity is higher than the affinity for any other epitope of the whole PTH sequence.

2. "Specifically binds to whole parathyroid hormone" means having a measurable affinity for and detectable binding to whole parathyroid hormone.

3. "Does not specifically bind to an interfering non-(1-84) parathyroid hormone fragment" means having no measurable affinity for and no detectable binding to an interfering non-(1-84) parathyroid hormone fragment.

4. "Not detecting an interfering non-(1-84) parathyroid hormone fragment" is construed to mean having no detectable binding to an interfering non-(1-84) parathyroid hormone fragment.

Document number 13 is from related application number 10/641,780. Document number 14 is from Patent Interference 105,575 (MPT) between U.S. Patent No. 6,838,264 and related application number 10/641,780.

Document numbers 15 and 16 are from application number 11/437,428. Applicants filed the present application to provoke Interference with application number 09/898,398. Application number 11/437,428 claims the benefit of application number 09/898,398.

Document numbers 17 and 18 are from application number 10/168,185. Applicants filed related application number 10/945,608 to provoke interference with application number 10/168,185. Document numbers 19-23 are from other applications filed by the Applicants that are related to PTH, but not in the same patent family as the present application.

Document number 24 is from reexamination Control No. 90/007,412. Applicants are the Third Party Requester in that matter.

Document numbers 25-28 are from related Japanese Patent Application No. 2000-593958. Document numbers 29 and 30 are from related Canadian Patent Application No. 2,360,020. Document numbers 31-35 are from related application number 10/617,489. Document numbers 36-38 are from related application number 10/945,608. Document numbers 39-40 are from related application number 11/799,726.

This Information Disclosure Statement is submitted:

- ☐ With the application; accordingly, no fee or separate requirements are required.
- ☐ Before the mailing of a first Office Action after the filing of a Request for Continued Examination under § 1.114. However, if applicable, a certification under 37 C.F.R. § 1.97 (e)(1) has been provided.
- ☐ Within three months of the application filing date or before mailing of a first Office Action on the merits; accordingly, no fee or separate requirements are required. However, if applicable, a certification under 37 C.F.R. § 1.97 (e)(1) has been provided.

- ☒ After receipt of a first Office Action on the merits but before mailing of a final Office Action or Notice of Allowance.
- ☐ A fee is required. A check in the amount of \_\_\_ is enclosed.
- ☒ A fee is required. Accordingly, a Fee Transmittal form (PTO/SB/17) is attached to this submission in duplicate.
- ☐ A Certification under 37 C.F.R. § 1.97(e) is provided above; accordingly, no fee is believed to be due.

Applicants would appreciate the Examiner initialing and returning the Form PTO/SB/08a/b, indicating that the information has been considered and made of record herein.

The information contained in this Information Disclosure Statement under 37 C.F.R. § 1.97 and § 1.98 is not to be construed as a representation that: (i) a complete search has been made; (ii) additional information material to the examination of this application does not exist; (iii) the information, protocols, results and the like reported by third parties are accurate or enabling; or (iv) the above information constitutes prior art to the subject invention.

In the unlikely event that the transmittal form is separated from this document and the Patent and Trademark Office determines that an extension and/or other relief (such as payment of a fee under 37 C.F.R. § 1.17 (p)) is required, Applicants petition for any required relief including extensions of time and authorize the Commissioner to charge the cost of such petition and/or other fees due in connection with the filing of this document to **Deposit Account No. 03-1952** referencing 532212000624.

Dated: March 2, 2009

Respectfully submitted,

By: 

Peng Chen

Registration No.: 43,543

MORRISON & FOERSTER LLP

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